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Hiroya Kobayashi

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DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER

AGGARWAL, YOGESH K

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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1. Applicant argues that neither Yamada nor Weale teach or suggest "a heat generation in the load resistor deteriorates characteristics of the solid-state imaging element.". This limitation has not been claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a "heat generation in the load resistor deteriorates characteristics of the solid-state imaging element") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, MPEP 2144 [R-6], SECTION IV teaches that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Finally MPEP 2144 [R-6], SECTION I also teaches that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally

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available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In this case, Yamada is only used to teach that the signal processing circuit is positioned at a planar portion of the package that differs from a planar portion at which the solid-state imaging element is positioned. It would be obvious to one skilled in the art that if the circuits are positioned at different planes from each other, that would save valuable real estate on the die area of the chip leading to overall cost savings.

2. Applicant argues that neither Yamada does not teach “the load resistor and the output terminal of the solid-state imaging element are electrically connected via the bonding wire”.

Yamada is not used to teach this limitation. Weale teaches this limitation “a package (case "C" in figure 2), housing the solid-state imaging element and the signal processing circuit, wherein the load resistor (chip resistor R) and the output terminal of the solid- state imaging element are electrically connected via a bonding wire (See figure 2 wherein the CCD "S" is connected to the resistor "R" via gold bonding wire "G", col. 3 lines 28-33)”

3. Applicant argues that Yamada discloses that the image processing semiconductor 9 is disposed so as to cover the image pick-up semiconductor 4 and is flip-chip-bonded to the wiring. Applicants respectfully submit that because the image pick-up semiconductor 4 is covered by the image processing semiconductor 9, the image pick-up semiconductor 4 and the image processing semiconductor 9 cannot be electrically connected via the bonding wire to any extent. The Examiner respectfully disagrees. Applicant has provided no reasoning as to why this is not possible. MPEP 2145 [R-6] teaches that the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to

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follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”).